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In re Application of :
DOUGLAS, Donald, et al. :
PCT No.: PCT/CA99/01142 : DECISION ON PETITION
U.S. Application No.: 09/857,234 :
International Filing Date: 30 November 1999 :
Priority Date: 02 December 1998 :
Attorney's Docket No.: 021340-00008 :
For: METHOD AND APPARATUS FOR MULTIPLE :
STAGES OF MASS SPECTROMETRY :
:

This decision is issued in response to the "Response To A Notification Of A Defective Oath Or Declaration" filed 29 August 2001, which is treated herein as a petition under 37 CFR 1.181 to confirm the submission of a declaration in compliance with 37 CFR 1.497. No petition fee is required.

BACKGROUND

On 30 November 1999, applicants filed international application PCT/CA99/01142 which claimed a priority date of 02 December 1998 and which designated the United States. On 08 June 2000, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB").

On 30 May 2000, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of the basic national fee was extended to expire thirty months from the priority date, i.e., 02 June 2001.

On 01 June 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a declaration executed by two of the three named inventors (the nonsigning inventor was Jennifer Campbell).

On 25 June 2001, applicants filed a substitute declaration, identical to the previously filed declaration except that it had now been executed by all three inventors.

On 03 July 2001 (apparently before the substitute declaration filed 25 June 2001 had been matched to the file), the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) and a Notification Of A Defective Oath Or Declaration (Form PCT/DO/EO/917) indicating that the declaration filed on

01 June 2001 was unacceptable under 35 U.S.C. 371(c)(4) because it: (1) was not executed by all the inventors and (2) did not identify the application to which it was directed. The Notification also noted that the declaration did not comply with 37 CFR 1.63 because it: (1) did not include the mailing address of each inventor; and (2) did not identify the foreign priority application. The Notifications required submission of a properly executed declaration in compliance with 37 CFR 1.497, and the surcharge for providing the oath or declaration later than thirty months from the priority date. Finally, the Notifications informed applicants that the failure to submit these materials within two months of the mail date of the Notifications would result in abandonment of the application.

On 26 July 2001, the DO/EO/US mailed a corrected Form PCT/DO/EO/905 and a corrected Form PCT/DO/EO/917. These forms were corrected to take into account the 25 June 2001 filing of the fully executed substitute declaration. The Notifications were identical to those mailed on 03 July 2001 except that the previously identified defect that the declaration was not executed by all the inventors was no longer listed.

On 29 August 2001, applicants filed the "Response To A Notification Of A Defective Oath Or Declaration" considered herein. This submission includes payment of the \$130 surcharge for filing the fully executed declaration after the thirty month deadline, and it argues that the previously filed declarations are in compliance with 37 CFR 1.497.

DISCUSSION

Section 602 of the M.P.E.P. (subsection "Identification Of Application") sets for the specific "combinations of information" required for a declaration to adequately identify the specification to which it applies. These requirements differ for declarations submitted on the application filing date (as was the partially executed declaration filed by applicants on 01 June 2001) or declarations filed at a later time (such as the substitute declaration executed by Jennifer Campbell and filed on 25 June 2001).

With respect to the declaration filed with the application papers on 01 June 2001, the M.P.E.P. states:

The following combination of information supplied in an oath or declaration filed on the application filing date with a specification are acceptable as minimums for identifying a specification and compliance with any one of the items below will be accepted as complying with the identification requirement of 37 CFR 1.63:

(A) name of inventor(s), and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration on filing.

Here, the declaration filed by applicants on 01 June 2001 referred to an attached specification, was filed with the materials initiating this national stage application (including a specification), and it lists all three inventors (although it is only executed by two of the three listed inventors, Bruce Collings and Donald J. Douglas). The declaration filed 01 June 2001 therefore adequately identified the specification to which it was directed. Accordingly, the original Forms PCT/DO/EO/905 and PCT/DO/EO/917 mailed 03 July 2001 were incorrect in stating that this declaration failed to adequately identify the specification to which it was directed. It is also noted that, as applicants assert in the present petition, the Application Data Sheet sets forth the required mailing addresses and priority information. Thus, the declaration need not include this information.

Based on the above, the declaration filed on 01 June 2001 is an acceptable declaration under 37 CFR 1.497 with respect to the inventors who executed it, that is, Bruce Collings and Donald J. Douglas. However, because the declaration was not executed by inventor Jennifer Campbell, the declaration does not satisfy the requirements of 35 U.S.C. 371(c)(4).

The 25 June 2001 declaration executed by the remaining inventor, Jennifer Campbell, was not submitted with the materials filed to initiate this national stage application on 01 June 2001; rather, the substitute declaration was submitted separately accompanied only by a cover letter entitled "Submission Of Substitute Declaration." Section 602 of the M.P.E.P. (subsection "Identification Of Application") states the following:

The following combinations of information supplied in an oath or declaration filed after the filing date of the application are acceptable as minimums for identifying a specification and compliance with any one of the items below will be accepted as complying with the identification requirement of 37 CFR 1.63:

(A) application number (consisting of the series code and the serial number, e.g., 08/123,456);

(B) serial number and filing date;

© attorney docket number which was on the specification as filed;

(D) title of the invention which was on the specification as filed and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or

(E) title of the invention which was on the specification as filed and accompanied by a cover letter accurately identifying the

application for which it was intended by either the application number (consisting of the series code and the serial number, e.g., 08/123,456), or serial number and filing date.

Here, the substitute declaration filed on 25 June 2001 did not include the application number, serial number, attorney docket number, or title of invention. The declaration therefore does not meet any of the "combinations of information" required to properly identify the specification to which the declaration was directed.

Based on the above, the corrected Forms PCT/DO/EO/905 and PCT/DO/EO/917 mailed 26 July 2001 were correct in asserting that the declaration filed 25 June 2001 did not adequately identify the specification to which it was directed and therefore cannot be accepted under 37 CFR 1.497. Applicants petition seeking acceptance of this declaration in satisfaction of 35 U.S.C. 371(c)(4) must therefore be dismissed.

CONCLUSION

The petition under 37 CFR 1.181 to confirm submission of a declaration in satisfaction of 35 U.S.C. 371(c)(4) and 37 CFR 1.497 is **DISMISSED** without prejudice.

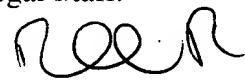
Applicant has submitted the required \$130 surcharge for filing the declaration later than thirty months after the priority date, and, as discussed above, has submitted an acceptable declaration from inventors Bruce Collings and Donald J. Douglas. However, the declaration filed on 25 June 2001 and executed by inventor Jennifer Campbell is unacceptable for failure to adequately identify the specification to which it was directed.

Applicants have **TWO (2) MONTHS** from the mail date of this decision to file a proper response. Such response should include a declaration executed by inventor Jennifer Campbell which complies with the requirements of 37 CFR 1.497 and which properly identifies the specification to which it is directed. Failure to file a timely and proper response will result in abandonment.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.


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